

REMARKS

Applicants respectfully submit that claims 1-59 are pending in the application.

Telephone Interview

Applicants thank the Examiner for contacting the undersigned on May 27, 2009 to request an oral election. During the telephone conversation, Applicants' representative requested a written Requirement. Applicants note for the record that the Summary Form (PTO-413) accompanying the Requirement sets forth the entire substance of the conversation.

Requirement

Restriction is required under 35 U.S.C. 121 and 372, as the application is asserted to contain the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1:

Group I, Claims 1-41 and 57-59, allegedly drawn to a biosensor product; and

Group II, Claims 42-56, allegedly drawn to a method of producing a biosensor product.

The requirement asserts that the inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 and asserts that U.S. Patent Application No. 2003/0217918 to DAVIES et al. teaches a rapid response glucose sensor. Applicants respectfully note that the Office does not further explain how DAVIES et al. affects the presently claimed invention, its general inventive concept, or any special technical feature. In the absence of such explanation, Applicants do not understand how the Restriction Requirement would be proper.

Election

In order to be responsive to the requirement for restriction and without acquiescing to or expressing agreement with the Office's comments concerning DAVIES et al., Applicants elect Group I, claims 1-41 and 57-59, drawn to a biosensor product, with traverse.

Traverse

Notwithstanding the election of Group I as the claimed invention, in order to be responsive to the requirement for election, Applicants respectfully traverse the requirement for restriction.

Initially, Applicants emphasize that the Office appears to not completely set forth how DAVIES et al. becomes a basis for the Restriction Requirement. In the absence of an explanation, Applicants respectfully request withdrawal of the Requirement.

Furthermore, Applicants note that this application is a national stage application, and therefore under unity of invention practice the Examiner must establish that the claims lack unity of invention under PCT Rule 13.1 and 37 C.F.R. § 1.475.

In particular, the Examiner is reminded that in determining unity of invention, the criteria set forth in 37 C.F.R. § 1.475 must be considered. Specifically, Applicants note that 37 C.F.R. § 1.475 provides:

Unity of invention before the International Searching Authority, the International Preliminary Examining Authority, and during the national stage.

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture, or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Thus, in stating the restriction requirement, the requirement must state why unity of invention is lacking under § 1.475. In the instant situation, the requirement does not refer to § 1.475, and does not indicate that the requirement is proper in view of this rule.

The requirement does point to PCT Rule 13.1 and PCT Rule 13.2, and asserts that what the Office alleges is the special technical feature of the method invention of Groups I-II result in a lack of unity of invention because of the disclosure of U.S. Patent Application No. 2003/0217918 to DAVIES et al. However, the requirement does not discuss § 1.475(b)(1), which permits an international or a national stage application containing claims to different categories of invention to have unity of invention if the claims are drawn only to one of the following combinations of categories including a product and a process specially adapted for the manufacture of said product. Therefore, the requirement for restriction is not proper for this reason also, and should be withdrawn.

In view of the foregoing, it is respectfully requested that the Examiner reconsider the requirement for restriction, and withdraw the same so as to give an examination on the merits on all of the claims pending in this application.


CONCLUSION

For the reasons discussed above, it is respectfully submitted that the Examiner's requirement for restriction is improper and should be withdrawn. Withdrawal of the requirement for restriction with the examination of all claims pending in this application is respectfully

requested. Favorable consideration with early allowance of the pending claims is most earnestly requested.

If the Examiner has any questions, or wishes to discuss this matter, please call the undersigned at the telephone number indicated below.

Respectfully Submitted,
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